

## REMARKS

### **I. General**

Claims 9-11, 14-29, 31-34, and 36-43 are pending herein. Claims 1, 2, and 4-8 are withdrawn. Claims 1-8, 12, 13, 30, and 35 are canceled herein. Claims 9, 15-20, 22-26, 31, 33, and 34 are amended herein. Claims 40-43 are new.

#### **A. Issues**

Claims 9-11, 14-23, 31, and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Publication Number 2002/0073039 to Ogg et al (hereinafter *Ogg*) in view of US publication Number 2001/0037320 to Allport et al. (hereinafter *Allport*).

Claims 24-29, 33, 34, and 36-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ogg in view of US Publication Number 2002/0073052 to Katikaneni et al. (hereinafter *Katikaneni*).

#### **B. Claim Amendments**

Claims 9, 15-20, 22-26, 31, 33, and 34 are amended herein. Claims 40-43 are new. Support for the amendments to claim 9 can be found in originally filed paragraphs [0009]-[0012] among other places. Support for the amendments to claim 24 can be found in originally filed paragraphs [0009]-[0012], [0015], and [0024] among other places. Claims 15-20, 22-26, 31, 33, and 34 are amended to track the language of their respective amended base claim.

The subject matter for new claim 40 can be found in paragraphs [0024]-[0026] among other places, and the subject matter for new claim 41 can be found in paragraph [0012] among other places. The subject matter in new claims 42-43 is found in paragraphs [0005]-[0015], [0028], [0039], and [0046] among other places.

Accordingly, no new matter is presented in the claim amendments. Thus, Applicant requests the amendments be entered.

## **II. Examiner Interview Summary**

### Applicants' Record Under § 713.04 of Personal Interview With Examiner

Applicant respectfully submits the following record of the in-person interview of July 15, 2009, under M.P.E.P. § 713.04.

On July 14, 2009, Examiner Rutao Wu and Applicant's attorneys R. Ross Viguet (Reg. No. 42,203) and Joni Collins (Reg. No. 59,354) participated in a personal interview which discussed the rejected claims.

The participants discussed traditional high-speed mail processing systems and how they are designed to operate as fast as possible to increase efficiency and decrease costs and distinguished such high-speed systems from the use of traditional postage stamps (e.g. a book of stamps purchased at the post office), which are not conducive for use in high-speed mail processing systems because they are costly (e.g. not in exact needed increments) and usually slow to apply which takes away from a high-speed system's efficiency and costs savings. At the conclusion of the interview, the participants agreed that certain claim amendments would more clearly claim the invention's inventive concept and distinguish over the cited art. For example, the participants agreed that machine generated postage stamps (e.g. printed labels that "spoof" postage stamps) were not taught by the references. In another example, the participants agreed that a high speed letter processing system that monitored the "location" of mail pieces in the system was not taught by the references. The discussed amendments are incorporated herein.

## **III. 35 U.S.C. §103 Rejections**

Claims 9-11, 14-29, 31-34, and 36-42 are pending in the current application. As explained below, the new claims are not taught by the cited references and should therefore be allowed.

The test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art. The United States Supreme Court in

*Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. As discussed further hereafter, Applicant respectfully asserts that the claims include nonobvious differences over the cited references. Thus, the rejections should be withdrawn because when considering the scope and content of the applied references there are significant differences between the applied combination and rejected claims, as the applied combination fails to disclose all elements of the rejected claims. Accordingly, considering the lack of disclosure in the applied combination of all elements of rejected claims, one of ordinary skill in the art would not find these claims obvious under 35 U.S.C. § 103, and therefore the rejections should be withdrawn at least for this reason.

**A. Claims 9-11, 14-23, 31, and 32 stand rejected over *Ogg* in view of *Allport***

Claim 9 recites “printing ... valid postage labels, wherein each of the valid postage labels comprise an image and a postage indicium ... wherein each of the postage indicia is associated with a particular one of the plurality of mail pieces ... and wherein the image is selected based upon one or more characteristics of the particular recipient.” As shown below, the *Office Action* has cited no reference or combination of references which teach printing a valid postage labels, which includes a postage indicium and an image which was selected for the recipient of a mail item.

*Allport* discloses indicium 30, which includes an image; however, *Allport* explains that the image included in indicium 30 is fixed. *Allport* at paragraph [0033]. Therefore, the image is not and cannot be selected for a particular recipient. Specifically, the image of *Allport*’s indicium 30 is a fixed “graphical design 31 (an eagle with stars).” As such, the image which is included in indicium 30 does not teach the claimed image because *Allport*’s image is not an image selected for the mail piece’s recipient.

*Allport* does print ads on the envelopes, but these printed ads do not teach the claimed image. The claim requires the image be included within the valid postage label, which must also include the indicium. In contrast, the ads and indicium in *Allport* are not printed in the

same location. See, *Allport* at figure 4. Furthermore, it would not be obvious to print the ads of *Allport* within the same location as the indicium because *Allport* explains that the ads can *not* be printed where “the *postage indicia* 30, the sender address 40, [or] the recipient address 50 are located.” *Allport* at [0034] (emphasis added). As such, *Allport* does not teach or make obvious valid postage labels comprising an image and a postage indicium, wherein the indicium is associated with the particular mail item and image is selected based upon one or more characteristics of the particular recipient.

*Ogg* and *Katikaneni* are other references cited by the *Office Action*. *Office Action* at 6 and 13. However, these references likewise do not teach the limitation. Accordingly, the cited references fail to teach or make obvious the limitations of the claim. Thus, Applicant requests the rejections of record be withdrawn and the claim be allowed.

Each of dependent claims 10-11 and 14-23 depend from independent claim 9. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03. As shown above, independent claim 9 is nonobvious. Thus, dependent claims 10-11 and 14-23 are likewise nonobvious. As such, Applicant requests the rejections of record be withdrawn and the claims be allowed.

The rejection of dependent claims 31 and 32 is improper. Both claims 31 and 32 depend from claim 24; however, the rejection of claims 31 and 32 fail to address at least some of the limitations included in claim 24 which are inherited into claims 31 and 32 through their dependence. Specifically, in the rejection of claim 24, the *Office Action* admits that certain limitations of the claim are not taught by *Ogg* and therefore relies on *Katikaneni* as teaching the limitations. *Office Action* at 13. Due to their dependency, claim 31 and 32 inherit those limitations; however, when rejecting claims 31 and 32 the *Office Action* fails to cite any reference as teaching those limitations which are admitted as not being taught by *Ogg*. Thus, because claims 31 and 32 are rejected over *Ogg* and *Allport* which is different from claims 24’s rejection over *Ogg* and *Katikaneni*, the rejection is flawed. Accordingly, because the rejection is improper, Applicant requests the rejections be withdrawn and the claims be allowed.

Further, “[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03. As will be shown below, independent claim 24 is nonobvious. Thus, dependent claims 31 and 32 are likewise nonobvious. As such, Applicant requests the rejections of record be withdrawn and the claims be allowed.

**B. Claims 24-30, 33, 34, and 36-39 stand rejected over *Ogg* in view of *Katikaneni***

Claim 24 recites “monitoring a location of mail pieces in a high-speed letter processing system . . . .” The *Office Action* relies on *Ogg* as teaching the limitation. However, as discussed in the Examiner Interview, the references do not teach monitoring the *location* of a mail item in a high-speed mail processing system. Thus, because at least this limitation is not taught by the references, Applicant requests the rejection be withdrawn and the claim be allowed.

Furthermore, claim 24 recites “creating valid postage labels associated with each of the mail pieces before the mail pieces arrive at a location comprising a postage indicium applicator . . . .” The *Office Action* cites *Ogg*, paragraph [0036], as teaching the limitation. *Office Action* at 13. However, while the reference generates indicia, the reference does not explain that valid postage labels are created *before the mail pieces arrive at the postage indicium applicator’s location*. Thus, because at least this limitation is not taught by the references, Applicant requests the rejection be withdrawn and the claim be allowed.

Even further, claim 24 recites “coordinating the operation of the postage indicium applicator and the location of the mail pieces to ensure that the correct valid postage labels are applied to each envelope.” As discussed in the Examiner Interview, the references cited do not disclose the level of sophistication needed to coordinate a high-speed postage system such that a specific valid postage label comprising a specific image and a specific indicium is applied to a specific envelope. As such, the cited references fail to teach at least this limitation of the claim, and Applicant requests the rejection of record be withdrawn and the claim be allowed.

Dependent claims 25-29, 33, 34, and 36-39 each depend from independent claim 24. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03. As shown above, independent claim 24 is nonobvious. Thus, dependent claims 25-30, 33, 34, and 36-39 are likewise nonobvious. As such, Applicant requests the rejections of record be withdrawn and the claims be allowed.

#### **C. New Claims 40 and 41**

New claims 40 and 41 depend from claim 24 thereby inheriting all the limitations therein. Thus, as least due to their dependence from claim 24, claims 40 and 41 are patentable as explained above.

Moreover, claim 40 recites “coordinating the location of the mail pieces and the operation of the postage indicium applicator and a postage evidencing system that creates the valid postage labels to ensure that the correct valid postage label is applied to each mail piece.” The references cited by the *Office Action* do not teach coordinating (1) the location of mail pieces, (2) the operation of a postage indicium applicator, and (3) the operation of a postage evidencing system that creates valid postage labels. Thus, the claim includes limitations which are nonobvious, and Applicant requests the claim be allowed.

Claim 41 requires printing the valid postage labels comprising postage indicia and comprising images “wherein each of the images is selected based on recipient characteristics of the particular one of the mail pieces . . . .” See the combination of claim 24 and 41. As explained above regarding claim 9, none of the references (or any combination thereof) relied upon by the *Office Action* appear to teach printing a valid postage label comprising both an indicium and an image selected based on characteristics of a mail piece’s recipient. As such, this claim is not taught by the references; thus, Applicant requests the claim be allowed.

#### **IV. New Claims 42 and 43**

Claim 42 recites “creating a machine generated postage stamp, by a high speed mail item computer processing system ... and affixing the machine generated postage stamp to the

mail pieces to provide mail pieces processed by the high speed mail item computer processing system which appear to have been prepared by hand.” As agreed to in the Examiner Interview, the *Office Action* has cited no reference or combination of references which teach a high speed mail processing system that creates machine generated postage stamps and affixes the stamps to mail pieces such that the mail pieces appear to have been prepared by hand. In contrast, the cited references merely disclose the use of traditional metering marks which are easily spotted and often disliked by mail recipients. For example, figure 4 of *Allport* shows postage indicia 30 which is obviously printed by a postage meter, does not appear to be a postage stamp, and is clearly not hand prepared. Likewise, figure 4A of *Katikaneni* shows indicia 30 which looks just like the postage indicia of *Allport* and likewise is obviously printed by a postage meter, does not appear to be a postage stamp, and is clearly not hand prepared. Furthermore, figure 6 of *Ogg* shows a printed indicia which likewise does not appear to be a traditional postage stamp and does not appear to be hand prepared. As such, the references relied upon by the *Office Action* do not appear to teach or make obvious at least this limitation of claim 42.

Claim 42 also recites “printing ... said machine generated postage stamp including a postage indicium and an image, wherein the postage indicium is associated with a particular one of the plurality of mail pieces ... and wherein the image is selected for a recipient of the particular one of the plurality of mail pieces. . . .” As explained with reference to claim 9, the *Office Action* has cited no reference or combination of references which teach printing postage stamps, which include a postage indicium and an image which was selected for the recipient of a mail item. As such, this limitation is also not taught by the references.

Thus, new claim 42 is not taught by the references. Accordingly, applicants request the claim be allowed.

Claim 43 depends from independent claim 42 thereby inheriting all the limitations therein. Thus, as least for the reasons detailed above with reference to claim 42, claim 43 is likewise patentable. Furthermore, claim 43 recites “wherein at least two of the machine generated postage stamps bear different images and different postage amounts.” The *Office Action* states that *Allport* discloses ads that can be selected and printed (see *Office Action* at 2-3); however, these disclosed ads do not teach the claimed different images. Claim 43

requires that the images be included in the postage stamp, and as explained above, *Allport* does not teach a machine generated postage stamp. Moreover, *Allport*'s ads are not even included in the meter mark (indicium 30). Rather, the ads are printed in any location *except for the indicium 30* location and the address locations. *Allport* at paragraph [0034]. Thus, regardless of whether *Allport* prints envelopes bearing differing ads, the taught ads do not teach claim 43.

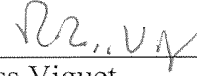
## V. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant requests that the claims be passed to issue.

Applicant believes that a \$405 fee for the RCE is due with this amendment, which is being paid by credit card. The one month extension of time fee will be paid in the extension of time request. Please charge any additional fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 61135-P022US-10303187 from which the undersigned is authorized to draw.

Dated: August 3, 2009

Respectfully submitted,

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Amendment Accompanying RCE  
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: August 3, 2009

Signature:   
(Lisa deCordova)